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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,494	10/30/2001	Jesse Donaldson	PALM-3674	1309

41066 7590 12/06/2006

WAGNER, MURABITO & HAO, LLP
TWO NORTH MARKET STREET, THIRD FLOOR
SAN JOSE, CA 95113

EXAMINER

KINDRED, ALFORD W

ART UNIT PAPER NUMBER

2163

DATE MAILED: 12/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,494

Applicant(s)

DONALDSON ET AL.

Examiner

Alford W. Kindred

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment, filed on 9/11/06.

This action is made final.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 11-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills et al, US# 2004/0048503 A1, in view of Dumas, US# 2002/0035574 A1.

As per claims 11 and 19, Mills et al. teaches "a name of a category associated with said removable memory" (see page 2, paragraph [0016]-[0019]) "with said main memory to said category associated with said removable memory" (see page 3, lines [0035]-[0038]) "in response thereto, automatically copying said application to said removable memory" (see page 4, paragraphs [0045]-[0046]). Mills et al. does not explicitly teach "choosing a category list . . . choosing an application name of said application from a category . . .". Dumas et al. teaches "choosing a category list . . . choosing an application name of said application from a category . . ." (see paragraph [0052], [0074], and [0099]). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Mills and Dumas, because using the steps of "choosing a category list . . . choosing an application name

of said application from a category . . .", would have given those skilled in the art the tools to segment, categorize, and process data associated with removable memories in systems such as a PDA. This gives users the advantage of effectively managing data removable memory environment. As per claim 12, Mills et al. teaches "removable memory is a SD (secure digital) card" (see page 5, paragraphs [0051]-[0052]).

As per claim 13, Mills et al. teaches "wherein said removable memory is a MMC (multi-media card)" (see page 6, paragraphs [0057] and [0078]).

As per claim 14, Mills et al. teaches "a compact flash (CF) card" (see page 4, paragraph [0044]).

As per claim 15, Mills et al. teaches "removing said application from said main memory" (see page 3, paragraphs [0035]-[0035]).

As per claim 16, Mills et al. teaches "displaying said category list on a display screen . . . a distinct visual attribute denoting external storage"(see page 10, paragraphs [0147]-[0149]).

As per claim 17, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 1 and is similarly rejected including the following:

--Mills et al. teaches "an expansion memory detachably coupled to a bus . . . built-in memory . . ." (see page 5, lines [0048]-[0052] and page 6, paragraph [0079]).

As per claim 18, Mills et al. teaches "categories is a category this is associated with said expansion memory" (see page 5, paragraphs [0051]-[0052]).

As per claim 20, Mills et al. teaches "automatically removed form said built-in memory . . ." (see page 5, paragraphs [0054]-[0055]).

As per claim 21, Mills et al. teaches "wherein said application is represented as an icon on said display device . . . expansion memory" (see page 10, paragraphs [0156]-[0159]).

As per claims 22-28, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 11-12 and 17-21 and are similarly rejected.

As per claims 29-32, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 11-16 and are similarly rejected.

Response to Arguments

4. Applicant's arguments with respect to claims 11-32 have been considered but are persuasive in view of the original ground(s) of rejection.

As per applicant's arguments regarding "Dumas teaches away from the claimed embodiments . . . Dumas to teach data transfer without changing a category name . . . teaches away . . . data transfer without a category name change . . .", examiner disagrees and maintains that Dumas teachings of the transfer of data from a remote database to a PDA (i.e. various PDAs with different formats), includes the changing, even if only by format, of a category name as illustrated in applicant's claim language. Further, PDAs have various editable software elements that allows for the organizing of incoming/outgoing data according to the user's need. Therefore the category name

change of applicant's claim language is a limitation that is editable by the user according to the software running on the PDA.

As per applicant's arguments regarding "Mills to teach that an expansion card may be coupled to a PDA . . . include a display screen . . . find on teaching or suggestion in Mills of updating of a displayable category list to comprise the name of a category associated with a removable memory as claimed", examiner disagrees and refer Applicant to Mill's expansion card. This expansion card contains data referencing data on a PDA and the data includes an identification element. The identification element is considered a category and as information on the PDA changes so does the identification element (see paragraph [0016] and [0046]), and therefore reads on applicant's claim language regarding updating a category list.

As per applicant's argument regarding "Applicants would like to respectfully point out that independent Claim 11 does not recite 'some type of list' . . . recites a category list which is updated to comprise a name of a category associated with a removable memory", examiner agrees that the Claim 11 does not recite "some type of list", however Applicant's claim language of reciting a category list comprising a name and an association with a removable memory, is taught by the expansion card of Mills. The expansion card is automatically recognized when inserted into a PDA and depending upon the information in a category or identifier element describes the current data, and in this case the list could be limited to one and thus Mills' teachings above reads on applicant's claim language (see paragraph [0016] and [0046]).

Conclusion

5. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 571-272-4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alford W. Kindred
Patent Examiner
Tech Ctr. 2100